

### **REMARKS**

Entry of the foregoing, and reconsideration and further examination of the subject application, in view of the amendments above and the remarks below, are respectfully requested.

### **Status of Claims**

By the above amendments, the description has been amended to provide a definition for the term "texanol." Additionally, independent claims 1, 22, 33, and 52 have been amended to specify that the plasticizer is miscible with the polyester. Support for the amendment may be found in the original description such as in paragraph [0009]. Independent claims 1, 22, and 70 have been amended to delete the language added in the last submission. Independent claims 33 and 85 have been amended to include the word "preparing" in the preamble for clarity. Dependent claims 11, 41, 59, 77, 91, and 106 have been amended to comply with proper Markush group language. Dependent claims 20-21 have been restored to their original form. And dependent claims 43-44 have been amended to be consistent with their independent claim. No claims have been deleted or added. Thus, upon entry of the foregoing amendments, claims 1-113 will remain pending in the application.

### **Claim Rejections - 35 U.S.C. § 112**

In the Office Action, claims 11, 24, 41, 59, 79, 91, and 106 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. To expedite prosecution, Applicants have amended all of the rejected claims, except for claim 79, to contain the Markush language suggested by the Examiner. The inclusion of claim 79 here appears to be in error. It is believed that claim 77 was intended, and that claim has also been amended to contain the Markush language suggested by the Examiner. In light of the above amendments, the rejection is now moot, and should be withdrawn.

### **Double Patenting**

Claims 1-113 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-33 of

copending Application No. 10/722,870. Since this is a provisional rejection, Applicants request that it be held in abeyance until an indication of allowability of the present claims.

### **Claim Rejections - 35 U.S.C. § 103**

Claims 1-15, 17-43, 45-60, 62-79, 81-92, 94-108, and 110-113 were rejected under 35 U.S.C. §103(a) as being unpatentable over WO 99/47605 to Flynn et al. ("Flynn") in view U.S. Patent 5,534,570 to Shih et al. ("Shih"), JP-4-117432 ("JP '432"), U.S. Patent 6,538,054 to Klatt et al. ("Klatt") or JP-2002-53740 ("JP '740"), and U.S. Patent 5,998,005 to Kanno ("Kanno"). Applicants respectfully traverse the rejection and the statements made in support thereof.

Flynn does not disclose or suggest each feature of the present invention, as set forth in representative claim 1. For example, Flynn does not disclose or suggest using a plasticizer that is miscible with the polyester. Flynn mentions that its composition can have a wide range of additives, including plasticizers. Page 7, line 27 – page 28, line 2. But Flynn does not disclose or suggest any particular kind of plasticizer, much less one that is miscible with the polyester.

Shih and JP '432 were cited for their teaching of plasticizers. However, neither of these references remedies the above-identified deficiency of Flynn. While both documents disclose the use of a plasticizer, neither reference distinguishes between miscible and immiscible plasticizers. In fact, miscibility between the plasticizer and the polyester is not mentioned at all. Both references, for example, disclose using an epoxy compound as the plasticizer. See Shih at col. 1, lines 60-65, and JP '432 at English abstract. However, as shown in Table 1 on page 13 of the present application, epoxy derivatives are not miscible with the polyester at temperatures of 160°C or below. Therefore, neither Shih nor JP '432 remedies the deficiency of Flynn because neither suggests using a plasticizer that is miscible with the polyester.

None of the remaining secondary references remedies the deficiency of Flynn mentioned above either. Neither Kanno nor JP '740 mentions plasticizers. And while Klatt mentions the possible use of plasticizers (col. 12, lines 21-25), it, like Shih and JP '432, does not suggest using a plasticizer that is miscible with the polyester. In fact, one

of its exemplary plasticizers, dioctyl phthalate (col. 12, line 53), is not miscible with the polyester at temperatures below 160°C. See Table 1 at page 15 of the present application.

Thus, even if the applied references could properly be combined, the combination would still not have led persons skilled in the art to arrive at the claimed invention. Accordingly, there is no *prima facie* case of obviousness, and the rejection should be withdrawn.

### Specification

The disclosure was objected to for the use of "texanol" without indicating it as a trademark. Applicants believe, however, that by defining the term as has now been done, the specification makes clear that the term is not being used in its trademark sense, but as short-hand for "2,2,4-trimethyl-1,3-pentanediol" as is commonly used in the art.

### Conclusion

In summary, Applicants believes the application to be in condition for allowance. Accordingly, the Examiner is respectfully requested to reconsider the rejection(s), enter the above amendment, remove all rejections, and pass the application to issuance.

Respectfully submitted,

Eastman Chemical Company  
P.O. Box 511  
Kingsport, Tennessee 37662  
Phone: (423) 229-3816  
FAX: (423) 229-1239

Louis N. Moreno  
Louis N. Moreno  
Registration No. 44,953  
April 21, 2006  
Date

#### CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Mail Stop Amendment, P. O. Box 1450, Alexandria, VA 22313-1450.

Karen Taylor  
Karen Taylor

4/21/2006  
Date